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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,939	04/05/2001	Ken R. Powell	104.024	3810

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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/825,939	POWELL, KEN R.
	Examiner	Art Unit
	Yehdega Retta	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological art; and

(2) whether the invention produces a useful, concrete, and tangible result.

For claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical science as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

The independently claimed steps of enabling a price adjustment, effecting a purchase, generating, receiving and processing signals do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. The claimed step of enabling a price adjustment, effecting a purchase, generating, receiving and processing signals does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of user or by use of a pencil and paper.

Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. The method only constitutes an idea of processing signals.

Additionally, for a claimed invention to be statutory the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces generating signal corresponding to offset of funds (i.e., repeatable) prediction (i.e., useful ant tangible). Although the recited process produces a useful, concrete and tangible result, since claimed invention, as a whole, is not with the technological art as explained above, the claims are deemed to be directed to non-statutory matter.

However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, in the preamble, recites a system including a retailer, and a plurality of manufacturer, and claim 2 recites wherein the system includes a store having shelves, product on the shelves etc., It is not clear whether the store is part of the retailer, or the store and the retailer are the same or whether the system includes a store and a retailer and manufactures. And it is not

clear how the store relates with the system, since it is recited, in claim 1 effecting the first purchase with the retailer and, in claim 2 effecting the first purchase in accordance with the display of the store. Clarification is required.

Claims 9 and 16 are rejects as stated above in claim 2, since the claims have similar limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-8, 10-15 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Schulze, Jr. U.S. Patent No. 6,497,360.

Regarding claims 1, 3-7, Schulze teaches enabling a price adjustment for a purchase, effecting the purchase, sending a first and second signal corresponding to the purchase,

processing the signals to generate a third signal corresponding to an offset of funds between a selected manufacturer and retailer; plurality of retailers, plurality of manufacturers, a first manufacturer having a computer system storing a monetary amount corresponding to the price adjustment, a checkout system (see fig. 4-9 and col. 4 lines 62- 67, col. 5 line 55 to col. 6 line 26, col. 7 lines 43-57, col. 8 lines 8-67, col. 10 lines 53-67).

Regarding claims 8 and 10-14, Schulze teaches a generator, in a retailer, that generate a first and second signal corresponding to a price-adjusted first purchase and a processor that receives signals and generates a signal corresponding to an offset of funds between a manufacturer and a retailer, plurality of retailers and manufacturers, a first manufacturer having a computer system storing a monetary amount corresponding to the price adjustment, a checkout system (see fig. 4-9 and col. 4 lines 62- 67, col. 5 line 55 to col. 6 line 67, col. 7 lines 1-57, col. 8 lines 8-67, col. 10 lines 53-67).

Regarding claims 15 and 17-21, Schulze teaches means for enabling a price adjustment for a purchase, means for effecting the purchase, means for sending a first and second signal corresponding to the purchase, means for processing the signals to generate a third signal corresponding to an offset of funds between a selected manufacturer and retailer; plurality of retailers, plurality of manufacturers, a first manufacturer having a computer system storing a monetary amount corresponding to the price adjustment, a checkout system (see fig. 4-9 and col. 4 lines 62- 67, col. 5 line 55 to col. 6 line 26, col. 7 lines 43-57, col. 8 lines 8-67, col. 10 lines 53-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze and further in view of Official Notice.

Regarding claims 2, 9 and 16, Schulze teaches retail stores selling products (see col. 5 lines 55-65). Schulze does not explicitly disclose the retail store displaying a discount level for products and effecting a purchase in accordance with the display. Official Notice is taken that is old and well known in the art of retail store to display discount level for product and to effect the purchase according to the displayed discount. One would be motivated to display discount level of a product in order to inform a customer of the discounted product and to charge the customer accordingly.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Guthrie et al. U.S. Patent No. 6,467,686 teaches electronically managing and redeeming coupons.

Fajkowski U.S. Patent No. 5,905,246 teaches coupon management and redemption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yehdega Retta
Primary Examiner
Art Unit 3622

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